

## **REMARKS**

Claims 1-25 are pending. Claim 12 has been amended. In view of the foregoing amendments, and the remarks that follow, reconsideration is respectfully requested.

### **Allowable Subject Matter**

Noted with appreciation is the indication in the Office Action that Claims 4-9, 15-17 and 22 recite allowable subject matter, and would be allowed if rewritten in independent form. In addition, as to Claims 15-17, the indication of allowability is subject to resolution of rejections under 35 U.S.C. §101. For reasons discussed in more detail later, it is believed that Claims 15-17 are all in full compliance with §101. In addition, Claims 4-9, 15-17 and 22 each depend from one of independent Claims 1, 12 and 20, and Claims 1, 12 and 20 are all believed to be allowable over the art for reasons discussed later. Accordingly it is believed to be unnecessary to convert any of dependent Claims 4-9, 15-17 and 22 into independent form at this time.

### **Interview Summary**

Applicants wish to make of record related telephone interviews that took place on April 9 and April 14, 2009. Following receipt of the Advisory Action mailed on March 20, 2009, the undersigned and Mr. Van Lindberg (of the undersigned's firm) contacted Examiner Pannala to request a telephone interview. That interview took place on April 9, 2009. The undersigned reiterated points made in the remarks of Applicants' last Response, including the fact that the Examiner declined to give patentable weight to the phrase "ordered access rules" on the theory that this phrase is in the preamble of Claims 12 and 20, when in fact this phrase appears in the body of each of Claims 12 and 20. No agreement was reached, and a decision was made to bring Supervisory Primary Examiner Charles Rones into the discussion.

A further telephone interview was held on April 14, 2009, involving the undersigned, Mr. Van Lindberg, Examiner Pannala and SPE Rones. During the interview, the undersigned again reiterated points made in the remarks of Applicants' last Response. In that interview, it was agreed that the Examiner would:

1. Withdraw the finality of the December 11 Office Action.
2. Withdraw the objection to the specification for lack of a summary section.
3. Withdraw the § 112 rejections.

4. Withdraw the § 101 rejections, except as to Claims 12-19. This included withdrawing §101 rejections relating to claim language reciting a “computer-readable medium”. As to Claims 12-19, even though these are apparatus claims that each have a preamble explicitly limited to a "system", SPE Rones suggested amending the body of Claim 12 to recite a specific hardware component.

### **Objection to Incomplete Office Action**

Applicants respectfully object to the Office Action because it is not complete. More specifically, the provisions of MPEP §707.07(f) instruct examiners that:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

In the present application, the Examiner issued a prior Office Action on December 11, 2008 rejecting independent Claims 1, 12, and 20 under 35 U.S.C. §103 based on a proposed combination of Harsham U.S. Patent No. 6,041,347, Nguyen U.S. Patent Application Publication No. 2003/0172145, and Pham U.S. Patent No. 7,143,288. On March 11, 2009, Applicants replied to the Office Action of December 11, 2008, in particular by filing a Response that traversed the rejections, including a number of specific and separate arguments addressing different aspects of the rejections in the December 11 Office Action. (Pages 16-23 in the Response filed March 11, 2009).

*The Examiner has never responded to a number of these arguments.* Applicant notes with appreciation that the current Office Action addresses a few of the arguments presented in the March 11 Response, but the following arguments are still awaiting a response by the Examiner:

1. Applicant's argument against the rejection of claims under 35 U.S.C § 103 based on non-analogous prior art. The Examiner asserted that Claims 1, 12, and 20 are obvious over a combination of Harsham, Nguyen, and Pham. However, MPEP §2141.01(a) states that: “To rely on a reference under 35 U.S.C. 103, it must be

analogous prior art”. (Capitalization and punctuation normalized). MPEP §2141.01(a) goes on to indicate that, as one important aspect of this, the Examiner must “consider similarities and differences in structure and function”. (Capitalization and punctuation normalized). Harsham, Nguyen, and Pham are not combinable under §103 because they have differences in structure and function that show that they are in non-analogous art areas.

2. Applicant’s argument regarding the claim language, “configured to contain independent rule blocks”. Claim 1 of the present application recites an “access control list” that is “configured to contain independent rule blocks having ordered access rules”. The Examiner doesn’t attempt to identify where the prior art teaches independent rule blocks, or how an access control list might “contain” or “hold” the independent rule blocks.
3. Applicant’s argument regarding the claim language “if the list is empty, creating a new independent rule block and inserting the new access rule therein”. The Examiner asserted that these limitations are taught by Nguyen at page 15, paragraph [0434]. However, there is nothing in that text that teaches “creating a new independent rule block,” “inserting,” or conditioning the insertion on the emptiness of a “list.”
4. Applicant’s argument regarding the claim language “a set of mapped independent rule blocks”. The Examiner has not shown how a cited section of Harsham teaches “rule blocks” that are “mapped,” “independent” or in a “set”. The Examiner does not apply any other reference to teach “rule blocks” that are “mapped,” “independent” or in a “set”. The Examiner thus does not show that each claim element was known in the prior art.
5. Applicant’s argument regarding the claim language “merging the blocks in the set to form a new independent rule block”. Although the word “merging” appears in the Pham reference, it appears in text that describes merging “server and client

communications functions,” and not merging “rule blocks” as recited in Claim 1. Further, Pham completely fails to mention “inserting the new access rule” into a merged block as recited by Claim 1.

6. Applicant’s argument regarding the claim language “a rule base,” as recited in Claim 12. The Examiner does not show a “rule base” in the prior art, and it is therefore impossible for the Examiner to claim equivalence between Claim 12 and any combination of Harsham, Nguyen, and Pham.
7. Applicant’s argument regarding the claim language “a rule insertion engine,” as recited in Claim 12. The Examiner does not show a “rule base” in the prior art, and it is therefore impossible for the Examiner to claim equivalence between Claim 12 and any combination of Harsham, Nguyen, and Pham.
8. Applicant’s argument regarding the claim language “a subset of the set comprising those blocks for which a position for the new access rule can be determined,” as recited in Claim 12. The Examiner does not show a “rule base” in the prior art, and it is therefore impossible for the Examiner to claim equivalence between Claim 12 and any combination of Harsham, Nguyen, and Pham.

Thus, the present Office Action repeats rejections from the last Office Action, but fails to “take note of the applicant's argument and answer the substance of it” as required by MPEP §707.07(f). Accordingly, it is respectfully submitted that the present Office Action is not complete, because it fails to comply with PTO requirements. It is therefore respectfully submitted that the present Office Action must be withdrawn, and replaced with a new and complete Office Action that does comply with MPEP 707.07(f).

#### **Claims 12-19 - Compliance With 35 U.S.C. § 101**

Claims 12-19 stand rejected under 35 U.S.C. §101 on the ground that “none of the claims are directed to software per se”. Pursuant to the suggestion made by SPE Ronces during the

interview held on April 14, 2009, Claim 12 has been amended to highlight specific hardware components used in the system. Specifically, Claim 12 has been amended to move the recitation of a "computer system" from the preamble to the body of the claim, and to add recitations of a "processor," and a "computer-readable medium" in the body of the claim, where the "processor" and "computer-readable medium" are inherent components of the previously-recited computer system. These changes do not alter the intended scope of Claim 12. Applicants believe that Claim 12 has never been directed to "software per se" but, in light of the foregoing modifications that add a recitation of specific hardware components to Claim 12, the claim is even more clearly not directed to "software per se." It is thus respectfully submitted that Claim 12 is in compliance with §101.

Claims 13-19 depend from Claim 12 and are believed to be compliant with 35 U.S.C. §101 for the same reasons as Claim 12. Applicants respectfully request notice that Claims 12-19 are in compliance with §101.

### **Claims 1, 12 and 20 - Non-Obviousness Under 35 USC § 103**

Independent Claims 1, 12, and 20 are rejected under 35 U.S.C. 103(a) as being obvious over a proposed combination of Harsham U.S. Patent No. 6,041,347, Nguyen U.S. Patent Application Publication No. 2003/0172145, and Pham U.S. Patent No. 7,143,288. These rejections are respectfully traversed, for the following reasons.

*a) The Office Action does not establish a prima facie case of obviousness because it does not show that each claim element was known in the prior art.*

In *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007), the United States Supreme Court addressed the issue of obviousness, and explained that:

A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. . . . it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.

*KSR* at 1731, 82 USPQ2d at 1389.

In other words, after showing that all of the claim elements are known in the prior art, the examiner must do more. But here, as discussed below, the Examiner has not met even the initial burden of "demonstrating that each element was, independently, known in the prior art".

1) Claims 1, 12, and 20 of the present application all recite "ordered access rules". In the "response to arguments" section on page 9 of the current Office Action, the Examiner asserts that "Applicant claimed ordered list has no significance and every list will have the order".

It is a clear error to merely assert that any claim limitations not found in the prior art have "no significance". MPEP 2143.03 requires that "All words in a claim must be considered in judging the patentability of that claim against the prior art."

On page 9 of the Office Action, the Examiner quotes language from paragraph [0553] of Nguyen. But the Examiner's citation to Nguyen is taken out of context. The Examiner omitted the introductory sentence in the paragraph cited in Nguyen, which states that: "The following is an exemplary process for planning for LDAP according to one embodiment, and is not intended to be limiting". Saying that elements of a "process for planning" may be in any order has no significance relative to ordered access rules.

Finally, the indicated portion of Nguyen actually teaches the opposite of what Applicants claim. If something can be in "other orders" or "overlapping," then it is in fact unordered, rather than ordered. An "ordered access rule" as recited by the claim is "ordered," rather than "overlapping" or in any other order.

2) Claim 1 of the present application recites a "list configured to contain independent rule blocks having ordered access rules". Claim 12 of the present application recites an "access control list configured to hold independent rule blocks having ordered access rules". Claim 20 of the present application recites an "access control list containing independent rule blocks having ordered access rules". The Examiner has not met the burden of showing how the prior art teaches that an access control list can "contain" or "hold" independent rule blocks. Because the Examiner has not applied any reference in the prior art to show how lists "contain" or "hold" rule blocks, the Examiner has not met the above-discussed requirement of "demonstrating that

each element was, independently, known in the prior art". For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

3) The Examiner has not met the burden of showing how the prior art teaches an independent rule block "having ordered access rules" as recited in Claims 1, 12, and 20. Because the Examiner has not applied any reference in the prior art to show how the independent rule blocks might have ordered access rules, the Examiner has not met the requirement of "demonstrating that each element was, independently, known in the prior art". For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

4) Claim 1 of the present application recites "if the list is empty, creating a new independent rule block and inserting the new access rule therein". Claim 12 of the present application recites "if the access control list is empty, creating a new independent rule block and inserting the new access rule therein". Claim 20 of the present application recites "creating a new independent rule block and inserting the rule therein if the list is empty". The Examiner has not met the burden of showing how the prior art teaches empty list handling. The Office Action asserts that these limitations are met by paragraph [0434] of Nguyen, where Nguyen states:

Another consideration may be: is the design to include a router Access Control List (ACL) and packet filters? Many ISPs choose to omit firewalls and implement router ACL and packet filters instead.

Considerations on whether to implement a firewall or router ACL and packet filters may include one or more of, but are not limited to, the following: routers are stateless and do not examine payload, and firewalls are necessary for stateful applications.

There is no reasonable interpretation of this quoted language that would amount to "creating a new independent rule block," "inserting," or conditioning the insertion on the emptiness of a "list". As the Office Action completely fails to show that the prior art discloses any of "creating a new independent rule block," "inserting" the block, or conditioning the insertion on the emptiness of a "list," the Examiner has not met the

requirement of “demonstrating that each element was, independently, known in the prior art”. For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

5) Claims 1, 12, and 20 of the present application all recite “a set of mapped independent rule blocks”. The Examiner has not met the burden of showing how the prior art teaches “a set of mapped independent” rule blocks. The Office Action asserts that this limitation is taught by Harsham, at col. 4, lines 25-28. The cited text in Harsham states, “[a]ccordingly, in the present invention, various logical groups of individual machines and groups of machines in the computer network may be defined”. However, since the Examiner has not shown how the prior art teaches “rule blocks” that are “mapped,” “independent” or in a “set,” the Examiner has not met the requirement of “demonstrating that each element was, independently, known in the prior art”. For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

6) The Examiner has not met the burden of showing how the prior art teaches “a rule base” as recited by Claim 12. This phrase does not appear anywhere in the text of the Office Action. Because the Office Action does not show a “rule base” in the prior art, it is impossible for the Office Action to claim equivalence between Claim 12 and the proposed combination of Harsham, Nguyen, and Pham. Accordingly, the Examiner has not met the requirement of “demonstrating that each element was, independently, known in the prior art”. For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

7) The Examiner has not met the burden of showing how the prior art teaches “a rule insertion engine” as recited by Claim 12. This phrase does not appear anywhere in the text of the Office Action. Because the Office Action does not show “a rule insertion engine” in the prior art, it is impossible for the Office Action to claim equivalence between Claim 12 and the proposed combination of Harsham, Nguyen, and Pham. Accordingly, the Examiner has not met the requirement of “demonstrating that



each element was, independently, known in the prior art". For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

8) The Examiner has not met the burden of showing how the prior art teaches "merging the blocks" as recited by claim 12. This phrase does not appear anywhere in the text of the Office Action. Because the Office Action does not show "merging the blocks" in the prior art, it is impossible for the Office Action to claim equivalence between Claim 12 and the proposed combination of Harsham, Nguyen, and Pham. Accordingly, the Examiner has not met the requirement of "demonstrating that each element was, independently, known in the prior art". For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

9) The Examiner has not met the burden of showing how the prior art teaches "a subset of the set comprising those blocks for which a position for the new access rule can be determined" as recited by Claim 12. This phrase does not appear anywhere in the text of the Office Action. Because the Office Action does not show that the prior art discloses "a subset of the set comprising those blocks for which a position for the new access rule can be determined", it is impossible for the Office Action to claim equivalence between Claim 12 and the proposed combination of Harsham, Nguyen, and Pham. Accordingly, the Examiner has not met the requirement of "demonstrating that each element was, independently, known in the prior art". For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

10) Claim 1 of the present application recites "merging the blocks in the set to form a new independent rule block and inserting the new access rule therein". Claim 12 of the present application recites "merging the blocks in a subset of the set comprising those blocks for which a position for the new access rule can be determined, and inserting the new access rule therein". Claim 20 of the present application recites "merging the blocks in the set to form a new independent rule block and inserting the rule therein". The Office Action asserts that these limitations are taught by Pham in Fig. 2 and at col. 6, lines 31-33. The indicated portion of Pham states that:

While using RPC-based messages functionally similar to the NFS protocol, the requirements for formal NFS compatibility are obviated and both server and client communications functions can be merged into a single, concisely defined secure virtual file system layer (SVFS).

Although the word “merging” appears in this text, the text is talking about merging “server and client communications functions,” and *not* merging “rule blocks” as recited in the claims. Further, the Office Action and Pham completely fail to mention “inserting the new access rule” into the merged block, as recited by the claims. Moreover, the recitation in Claim 12 of “merging the blocks in a subset of the set comprising those blocks for which a position for the new access rule can be determined” is completely ignored. Accordingly, the Examiner has not met the requirement of “demonstrating that each element was, independently, known in the prior art”. For this reason, it is respectfully submitted that the rejections are improper and must be withdrawn.

*b) The Office Action does not establish a prima facie case of obviousness because the references are not properly combinable.*

Applicants previously argued that the references teach away from the combination proposed by the Examiner. In the response to arguments section on page 8 of the current Office Action, the Examiner mischaracterizes Applicant’s argument on this point. Specifically, as stated in the Office Action (emphasis added to highlight differences):

Applicant argued regarding claims rejection under 35 U.S.C. 103 as “It is [improper] . . . to combine references *where the references teach away from their combination.*”

In response to applicant’s argument that *there is no suggestion to combine the references....*

(Emphasis added).



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As shown by the emphasized portions in this quote from the most recent Office Action, the argument made by the Applicant is not the argument addressed by the Examiner. As detailed

further below, Harsham, Nguyen, and Pham are not properly combinable *because the references teach away from their combination*.

More specifically, MPEP §2145 X(D)(2) provides that: “It is improper to combine references where the references teach away from their combination”. The Office Action asserts that Harsham, Nguyen, and Pham should be combined. However, Nguyen and Harsham give directly opposite and inconsistent prescriptions as to how to solve problems of growth and scalability, and Pham is in a different art area altogether.

In the “response to arguments” section on page 8 of the Office Action, the Examiner refers to “applicant’s argument that there is no suggestion to combine the references”. However, Applicants’ argument was not saying that there is no suggestion to combine the references. Instead, what Applicants argued is that Harsham and Nguyen explicitly teach away from each other and are directly inconsistent. Therefore, the Examiner’s reply fails to answer Applicant’s argument.

In more detail, Nguyen states that early ISPs were not able to “scale their systems capacity” because they “combined the few required applications onto a single server” and pursued a “monolithic architecture design”. Nguyen therefore proposes a distributed architecture. Nguyen at paragraph [0005], abstract. In contrast, Harsham states that “management of very large computer networks that are geographically dispersed is a difficult task” and prescribes a “centralized computer network management system”. Harsham, col 1, ll. 39-41, 48-50.

Thus, Harsham expressly teaches directly away from Nguyen’s distributed system, and Nguyen expressly teaches directly away from Harsham’s centralized system. Because Harsham and Nguyen have diametrically opposed prescriptions for achieving the purported result of greater “growth and agility,” the Examiner’s suggestion to combine these references under §103 in order to achieve this particular result is improper under MPEP §2145 X(D)(2), and constitutes clear error. Adding Pham does not cure this deficiency, because Pham has not been applied (and does not apply) to the two prescriptions of scalability. For this reason, it is respectfully submitted that the references are not properly combinable, and so the rejection under §103 must be withdrawn.

*c) The Office Action does not establish a prima facie case of obviousness because the references are not analogous art under to MPEP §2141.01(a).*

MPEP §2141.01(a)(I) specifies that: “To rely on a reference under 35 U.S.C. 103, it must be analogous prior art”. It is respectfully submitted that Harsham, Nguyen and Pham are each non-analogous with respect to the others, and so they cannot be combined.

More specifically, Pham’s abstract explains that Pham is directed to a “security file system layer interposed between the platform operating system kernel and file system.” As described by Pham, the security file system layer is at the very lowest layer of the operating system, directly integrated with the kernel on a single machine. In contrast, the abstract and paragraph [0005] of Nguyen explain that Nguyen is directed to a multi-machine distributed ISP architecture, and Harsham’s abstract explains that Harsham is directed to a “centralized computer network management system that simultaneously configures and monitors computers in a computer network.”

MPEP §2141.01(a)(II) states that “differences in structure and function” show that different references are nonanalogous. In this case, the differences in structure and function could not be more striking. Pham operates at the *kernel* level on file systems. Harsham operates at the *application* level to configure networks. Nguyen operates at the *network* level as a service provider architecture. The disconnect between the Harsham, Nguyen and Pham systems is so significant that the suggested integration of the three references is without merit. The Examiner’s suggestion to combine these references under §103 is improper under MPEP §2141.01(a), and constitutes clear error. For this reason, it is respectfully submitted that the Harsham, Nguyen and Pham references are not properly combinable, and that the rejections under §103 must be withdrawn.

#### **Dependent Claims 2-3, 10-11, 13-14, 18-19, 21 and 23-25**

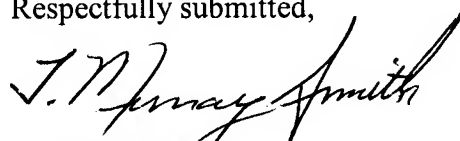
Claims 2-3 and 10-11, Claims 13-14 and 18-19, and Claims 21 and 23-25 respectively depend from Claim 1, Claim 12, and Claim 20, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claims 1, 12 and 20, respectively.

**Conclusion**

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Although Applicants believe that no additional fees are due, the Commissioner is hereby authorized to charge any fees required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone, LLP.

Respectfully submitted,



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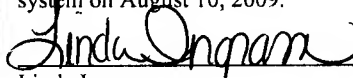
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Linda Ingram